

Appln No. 10/079,293

Amdt date March 9, 2005

Reply to Office action of December 17, 2004

**REMARKS/ARGUMENTS**

The above amendments and these remarks are responsive to the Office Action mailed on December 17, 2004. Claims 16, 28 and 43 have been amended. Specifically, claims 28 and 43 have been amended for clarity. Claim 17 and 42 have been canceled. Claims 44-46 have been added. Claims 9-16, 20-41, and 43-46 are now pending in this application. Reconsideration on the basis of the above amendments and remarks below is kindly requested.

The Examiner rejected claims 16, 20, 24, 35 and 36 as being anticipated by Flood, et al. However, it appears that the Examiner made a mistake in identifying the patent number of Flood. The correct patent number of Flood is 5,494,477 and not 5,711,702 as stated in the Office Action. The Examiner, also, objected to claim 17 but stated that the claim would be allowable if rewritten in independent form including all the limitations of its base claim and any intervening claims. Claim 17 was dependent from claim 16.

Claim 16 has been amended to include the limitations of claim 17. As such, applicants submit that claim 16 is now in condition for allowance. Claims 20, 24, 35 and 36 are dependent from claim 16. As such, applicants submit that claims 20, 24, 35 and 36 are also in condition for allowance as being dependent from an allowable base claim and for the additional limitations they contain therein.

The Examiner rejected claims 21, 22, 27, 28, 38, 39 and 43 under 35 USC, §103(a) as being unpatentable over Flood in view of Devlin, U.S. Patent No. 5,711,702. Claims 21 and 22 are dependent from claim 16. Claim 16 is now believed to be in

**Appln No. 10/079,293**

**Amdt date March 9, 2005**

**Reply to Office action of December 17, 2004**

condition for allowance. As such, applicants submit that claims 21 and 22 are also in condition for allowance as being dependent from an allowable base claim and for the additional limitations they contain therein.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Circ. 1991). See also MPEP 2143.

According to the Examiner, Flood discloses the invention of claims 27, 28, 38, 39 and 43 as claimed except for the non-uniform portion in the canted or/and uncanted portions. However, according to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the canted or uncanted portions of Flood, et al. with rounded and pointed projections in view of the teachings of Devlin in order to reduce the risk of delamination.

Claims 27 is directed to a cutting element having a hard material body, having an end surface comprising a canted portion and "an uncated portion comprising a non-uniform portion". Claims 28 and 43 are directed to a cutting element having a hard

**Appln No. 10/079,293**

**Amdt date March 9, 2005**

**Reply to Office action of December 17, 2004**

material body "wherein at least part of said canted and uncanted portions comprise a non-uniform portion". Flood does not teach forming a non-uniform surface on an uncanted portion of a hard material body. Devlin teaches forming a non-uniform surface on what appears to be a canted body interface surface. Devlin also does not appear to disclose forming a non-uniform portion on an uncanted surface of a hard material body.

According to the third criteria for a *prima facie* of obviousness, the prior art references must teach or suggest all of the claimed limitations. Neither of the prior art references discloses, teaches or suggests forming a hard body having an end surface having a canted and an uncanted portion wherein the uncanted portion comprises a non-uniform portion as required by claims 27, 28 and 43. As such, the combination of these two references cannot render claims 27, 28 and 43 obvious.

Claims 38 and 39 are dependent from claims 27 and 28, respectively. As such, applicants submit that claims 38 and 39 are also in condition for allowance as being dependent from an allowable base claim and for the additional limitations they contain therein.

Claims 44-46 have been added and are directed to subject matter disclosed in the application as originally filed. No new matter has been added. Claim 44 is directed to a cutting element having a hard material body having an end surface having a canted and an uncanted portion wherein a non-uniform portion is formed on the canted and uncanted portions. Claim 45 is directed to a cutting element having a hard material body, having an end surface having a canted and an uncanted portion

**Appln No. 10/079,293**

**Amdt date March 9, 2005**

**Reply to Office action of December 17, 2004**

wherein a non-uniform portion is formed on the uncanted portion. As discussed in relation to the rejections to claims 27, 28 and 43, the prior art does not disclose, teach or suggest forming a cutting element having a hard material body having an end surface, having a canted and an uncanted portion wherein a non-uniform portion is formed on the canted and uncanted portions, or on the uncanted portion as required by claims 44 and 45, respectively. As such, applicants submit that claims 44 and 45 are also allowable over Flood in view of Devlin.

Claims 46 has been added and is dependent from claim 27. Claim 27 is now believed to be in condition for allowance. As such, applicants submit that claim 46 is also in condition for allowance as being dependent from an allowable base claim and for the additional limitations it contains therein.

The Examiner objected to the drawings. New FIG. 9G is being submitted herewith. FIG. 9G finds support in the application as originally filed. No new matter has been added.

The Examiner objected to the title. The title has been changed to overcome this objection.

The rejections and objections to all claims pending in this application are believed to have been overcome and this application is now believed to be in condition for allowance.

Appln No. 10/079,293

Amdt date March 9, 2005

Reply to Office action of December 17, 2004

Should the Examiner have any remaining questions or concerns about the allowability of this application, the Examiner is kindly requested to call the undersigned attorney to discuss them.

Respectfully submitted,  
CHRISTIE, PARKER & HALE, LLP

By 

Constantine Marantidis  
Reg. No. 39,759  
626/795-9900

CM/cmt

CMT PAS608594.1--03/9/05 2:24 PM

Appln No. 10/079,293

Amdt date March 9, 2005

Reply to Office action of December 17, 2004

**Amendments to the Drawings:**

The attached sheet of a drawing includes new FIG. 9G. FIG. 9G finds support in the application as originally filed. No new matter has been added.

Attachment: New Drawing Sheet - FIG. 9G